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Filing date: **11/14/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91206211
Party	Plaintiff ABM Wireless, Inc. d/b/a Mobileistic
Correspondence Address	BRIAN A BLOOM MORITT HOCK & HAMROFF LLP 400 Garden City Plaza2nd Floor Garden City, NY 11530 UNITED STATES bbloom@moritthock.com, msarney@moritthock.com
Submission	Motion to Suspend for Civil Action
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Date	11/14/2014
Attachments	motion to suspend 91206211.pdf(957668 bytes)


ABM Wireless, Inc.,)	Opposition No.: 91206211
)	
)	
Opposer/Counterclaim Registrant,)	
v.)	
)	
Mophie, Inc.,)	
)	
Applicant/Counterclaim Petitioner.)	
)	



Opposer and Counterclaim Registrant, ABM Wireless, Inc. ("ABM"), hereby submits this Motion to Suspend for Civil Action.


The grounds for the motion are more fully set forth in Opposer's brief in support of the Motion, which is embodied herein pursuant to C.F.R. §2.127(a).




Pursuant to Trademark Rule 2.117(a), whenever it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action, proceedings before the Board may be suspended until final determination of the civil action. General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933 (TTAB 1992). Suspension of a Board proceeding is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling may have a bearing on the rights of the parties in the Board case. See Martin Beverage Co. Inc. v. Colita Beverage Company, 169 USPO 568, 570 (TTAB 1971).

Here, ABM and Mophie, Inc. ("Mophie") are parties to a civil action, pending in the Central District of California, Case No. 14-civ-01422-JLS-RNB. Said action was commenced by Mophie, on September 5, 2014, by the filing of a Complaint for a

Declaratory Judgment that its use of the mark  does not infringe ABM's rights in

the marks  and , covered by U.S. Trademark Registration Nos. 4,011,446 and 4,051,955, respectively. A copy of the Complaint is attached hereto as Exhibit A. In the Complaint, Mophie alleges, *inter alia*, that it has priority over ABM in the use of its mark.

ABM filed its Answer to the Complaint, and a Counterclaim against Mophie for infringement of Registration No. 4,011,445, for the  mark, on November 13, 2014. Copies of the Answer and Counterclaim are attached hereto as Exhibits B and C, respectively. In the period of time between the filing of the Complaint and ABM's Answer and Counterclaim, the parties had been attempting to settle their dispute, including this Opposition, to no avail.

In this Opposition, ABM has opposed registration by Mophie of the  mark, based on ABM's Registration Nos. 4,011,445, for its  mark, and 4,051,955 for the  mark. Additionally, Mophie has filed a Counterclaim, in this proceeding, seeking cancellation of said registrations.

Thus, it is clear from the pleadings that a ruling in the civil action will certainly have a bearing on the rights of the parties in this Opposition, and will likely be dispositive thereof. Indeed, priority as to various "m" formative marks is at the heart of the parties' disputes. Accordingly, it is appropriate for the Board to exercise its discretion and suspend this Opposition pending a final disposition of the civil action.

For the foregoing reasons, ABM's Motion to Suspend for Civil Action should be granted.

Dated: November 14, 2014

Respectfully submitted,

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By: 
Michael F. Sarney

Attorneys for ABM Wireless, Inc.

CERTIFICATE OF SERVICE

I, the undersigned, Michael Sarney, hereby certified that on the 14th day of November, 2014, I caused to be served a true and correct copy of the foregoing

OPPOSER'S MOTION TO SUSPEND FOR CIVIL ACTION

By U.S. Mail, by depositing the same in a depository of the United States Postal Service, on the Applicant, as follows:

Linda H. Liu
KNOBBE MARTENS OLSON & BEAR LLP
2040 Main St., 14th Floor
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Attorneys for Mophie, Inc.

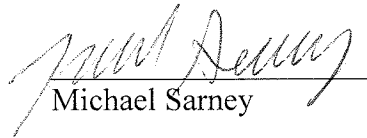

Michael Sarney

EXHIBIT A

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6 Attorneys for Plaintiff MOPHIE, INC.
7
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9

10 IN THE UNITED STATES DISTRICT COURT
11 FOR THE CENTRAL DISTRICT OF CALIFORNIA

12 MOPHIE, INC., a California
13 corporation,

14 Plaintiff,

15 v.

16 ABM WIRELESS, INC. d/b/a
17 MOBILEISTIC, a New York
corporation.




18 Defendant.
19

Civil Action No. 8:14-cv-01422

**COMPLAINT FOR
DECLARATORY JUDGMENT
OF NON-INFRINGEMENT OF
TRADEMARK RIGHTS**

1 Plaintiff mophie, Inc. (“mophie”) brings this Complaint for Declaratory
2 Judgment of Non-Infringement of Trademark Rights against Defendant ABM
3 Wireless, Inc. d/b/a Mobileistic (“ABM”) and alleges as follows:

4 **I. NATURE OF THE ACTION**

5 1. This declaratory judgment action seeks to clarify mophie’s right to
6 use its  mark. This action is filed in response to ABM’s threats to engage
7 in litigation to stop such use based on its alleged rights in the marks  and
8 mobileistic. ABM should not be permitted to enforce its
9 purported marks against mophie, and mophie is entitled to a declaration that its
10 mark does not infringe ABM’s rights.

11 **II. JURISDICTION AND VENUE**

12 2. This Court has subject matter jurisdiction over this action pursuant
13 to 28 U.S.C. § 1331, 1332, and 2201 and 15 U.S.C. §§ 1114 and 1125.

14 3. This Court has personal jurisdiction over ABM because ABM has a
15 continuous, systematic, and substantial presence within this judicial district
16 including by enforcing its trademark rights against companies that reside in this
17 District and by having a business address within this district.

18 4. Venue is proper in this judicial district under 28 U.S.C. §1391.

19 **III. THE PARTIES**


20 5. Plaintiff mophie, Inc. is a corporation organized and existing under
21 the laws of the State of California, having its principal place of business at
22 15101 Red Hill Avenue, Tustin, CA 92780.

23 6. mophie is informed and believes, and thereon alleges, that
24 Defendant ABM Wireless, Inc. d/b/a Mobileistic is a corporation organized and
25 existing under the laws of the State of New York, having its principal place of
26 business at 205 Marcus Blvd., Hauppauge, New York 11788. Upon information
27 and belief, ABM also has an office within this district at 905 Columbia St. in
28 Brea, California.

1 **IV. GENERAL ALLEGATIONS**

2 **A. mophie is an innovator and market leader in battery cases**

3 7. mophie designs and develops innovative products in the consumer
4 electronics area. These products include several protective battery case designs
5 for the iPhone sold by Apple, Inc. (“Apple”) and other smartphones, which
6 provide both a protective case and a portable backup battery source that can
7 recharge the phone if its internal battery is drained of power.

8 8. Since at least as early as 2007, mophie has marketed and sold its
9 high quality consumer electronics products in connection with the mark 
10 (the “mophie Mark”).

11 9. mophie has invested a considerable amount of time and money in
12 establishing the mophie Mark in the minds of consumers as a source of high
13 quality products. As a result of mophie’s substantial use and promotion of the
14 mophie Mark in connection with consumer electronics and other products, the
15 mark has acquired great value as an identifier of mophie’s products and serves
16 to distinguish mophie’s products from those of others. According to third party
17 industry estimates, mophie has consistently held a dominant market share in the
18 charging case market and currently holds a market share of approximately 90%.

19 **B. ABM’s improper threats of infringement**

20 10. After mophie and its mophie Mark became well-established in the
21 consumer electronics industry, ABM began contacting mophie to assert a claim
22 of trademark infringement.

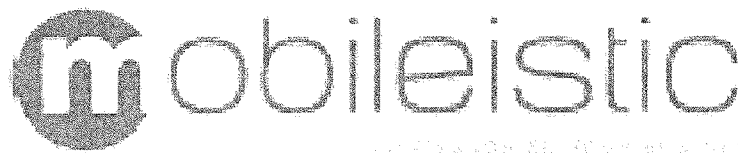
23 11. On or about March 19, 2012, ABM wrote to mophie and asserted
24 that mophie infringes ABM’s trademarks, including U.S. Trademark
25 Registration Nos. 4,011,446 and 4,051,955 (collectively, the “Alleged ABM
26 Marks”) through use of the mophie Mark. In its letter, ABM alleged that
27 mophie has been trading on the name, goodwill and reputation of ABM and that
28 mophie’s actions constitute trademark, trade dress and trade name infringement,

1 as well as unfair competition under 15 U.S.C. § 1125(a).

2 12. Subsequent to this initial correspondence, ABM has continued to
3 communicate with mophie in writing and in person regarding ABM's
4 accusations of trademark infringement.

5 13. Upon information and belief, ABM did not begin using the Alleged
6 ABM Marks in connection with consumer electronics products until 2012, years
7 after the mophie Mark became a well-known mark in the industry due to
8 mophie's efforts to use and promote the mophie Mark.

9 14. There is no likelihood of confusion between the Alleged ABM
10 Marks and the mophie Mark, and there are several differences between the
11 Alleged ABM Marks and the mophie Mark. Upon information and belief, ABM
12 has consistently used the Alleged ABM Marks in commerce as shown below
13 with a purple background and purple lettering.



18 15. In contrast, mophie has consistently used the mophie Mark with a
19 black background.

20 16. In addition, several other parties use "Circle M" marks in
21 connection with batteries, battery chargers, headsets or other related goods,
22 including but not limited to U.S. Registration No. 1792437 owned by Multiplier
23 Industries Corp., shown on the left, a mark used by MyCharge for charging
24 banks, shown in the middle, and U.S. Registration No. 3477883 to Motorola,
25 shown on the right:

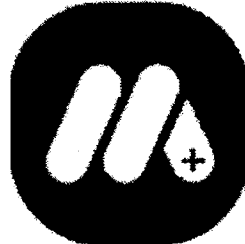
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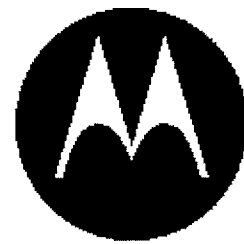
28 ///



U.S. Registration No. 1792437



MyCharge logo



U.S. Registration No. 3477883

17. The fact that other parties in the industry use a Circle M logo for battery and charging-related products further emphasizes the lack of any confusion between the Alleged ABM Marks and the mophie Mark.

18. mophie has obtained its own registrations for the mophie Mark, including U.S. Registration Nos. 3681443 and 3958080, demonstrating that the Patent and Trademark Office did not identify any likelihood of confusion between the mophie Mark and the Alleged ABM Marks.

19. Despite the lack of any confusion between the Alleged ABM Marks and the mophie Mark, ABM has maintained its position that mophie infringes the Alleged ABM Marks.

20. In July 2014, the president of ABM attended an in-person meeting at mophie's facilities in Tustin, California to further discuss ABM's assertions and mophie's continued use of the mophie Mark and has had continued discussions with mophie.

21. In these discussions, ABM has demanded that mophie pay an exorbitant monetary sum to resolve this matter short of litigation. The amounts demanded by ABM appear to be an effort to extract a large financial payout from mophie, rather than a good-faith effort to resolve the parties' dispute.

22. ABM's actions and conduct create a reasonable apprehension of litigation and a justiciable controversy between the parties regarding mophie's right to continue using the mophie Mark. Unless mophie agrees to the unreasonable demands made by ABM, mophie will continue to face a threat that

1 ABM will assert infringement of the Alleged ABM Marks.

2 **V. CLAIM FOR RELIEF**

3 (Declaratory Judgment of Non-Infringement of Trademark Rights)

4 (15 U.S.C. §§ 1114 and 1125)

5 23. mophie repeats and re-alleges the allegations of Paragraphs 1-22 of
6 this Complaint as if set forth fully herein.

7 24. There is no likelihood of confusion between the Alleged ABM
8 Marks and the mophie Mark.

9 25. mophie has not infringed and does not infringe any of ABM's
10 rights. mophie is entitled to use the mophie Mark without any interference by
11 ABM.

12 26. A judicial declaration is necessary and appropriate so that mophie
13 may ascertain its rights with respect to the mophie Mark.

14 **WHEREFORE**, mophie prays for judgment in its favor against ABM for
15 the following relief:

16 A. This Court enter a judgment declaring that mophie has not infringed
17 and is not infringing any of ABM's Alleged Marks;

18 B. This Court enter a judgment declaring that mophie has the lawful right
19 to continue to use the mophie Mark in connection with the manufacture, display,
20 advertising, marketing, promotion, sale, offer for sell, and/or importation into
21 the United States of its products without threat or interference by ABM;

22 C. ABM and its agents, representatives, attorneys, and those persons in
23 active concert or participation with them who receive actual notice hereof, be
24 preliminarily and permanently enjoined from threatening or initiating
25 infringement litigation against mophie or any of its customers, distributors,
26 dealers, or suppliers, or any prospective customers, distributors, dealers, or
27 suppliers of mophie, or charging any of them with infringement of any of
28 ABM's Alleged Marks;

1 D. This Court award mophie its reasonable attorneys' fees and costs
2 under 15 U.S.C. § 1117;

3 E. mophie be awarded relief under 28 U.S.C. § 2202; and

4 F. mophie be awarded such other and further relief as this Court deems
5 just.

6 Respectfully submitted,

7 KNOBBE, MARTENS, OLSON & BEAR, LLP
8

9 Dated: September 5, 2014 By: /s/ Sheila N. Swaroop

10 Steven J. Nataupsky
11 Sheila N. Swaroop

12 Attorneys for Plaintiff MOPHIE, INC.
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EXHIBIT B

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Attorneys for Defendant/Counterclaimant

ABM WIRELESS, INC.

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

MOHPIE, INC., a California corporation,

Plaintiff,

v.

ABM WIRELESS, INC. d/b/a MOBILEISTIC, a
New York corporation,

Defendant.

ABM WIRELESS, INC., a New York
corporation,

Counterclaimant,

v.

MOHPIE, INC., a California corporation,

Counterdefendant.

) Case No.: SACV 14-01422 JLS(RNBX)

)

) The Hon. Josephine L. Staton, Courtroom 10A

)

) **DEFENDANT ABM WIRELESS, INC.'S**

) **ANSWER AND AFFIRMATIVE DEFENSES**

) **TO PLAINTIFF'S COMPLAINT**

)

) **[Counterclaim of ABM Wireless, Inc. Filed**

) **Concurrently Herewith]**

)

) COMPLAINT FILED: September 5, 2014

) TRIAL DATE: None Set

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ANSWER

Pursuant to Rule 8(b) of the Federal Rules of Civil Procedure, Defendant ABM Wireless, Inc. d/b/a Mobileistic (“Mobileistic” or “Defendant”) answers the Complaint (“Complaint”) of Plaintiff Mophie, Inc. (“Mophie” or “Plaintiff”). If an averment is not specifically admitted, it is hereby denied.

NATURE OF THE ACTION

1. Answering paragraph 1, Defendant denies each and every allegation contained therein.

JURISDICTION AND VENUE

2. Defendant admits that this Court has subject matter jurisdiction over this action.

3. Defendant admits that this Court has personal jurisdiction over Defendant. Except as expressly admitted herein, Defendant denies each and every allegations contained in this paragraph.

4. Defendant admits that venue is proper in this judicial district.

PARTIES

5. Answering paragraph 5, Defendant lacks sufficient information to admit or deny the allegations contained therein, and on that basis denies each and every such allegation.

6. Answering paragraph 6, Defendant admits the allegations contained therein.

GENERAL ALLEGATIONS

7. Answering paragraph 7, Defendant lacks sufficient information to admit or deny the allegations contained therein, and on that basis denies each and every such allegation.

8. Answering paragraph 8, Defendant denies each and every allegation contained therein.

9. Answering paragraph 9, Defendant lacks sufficient information to admit or deny the allegations contained therein, and on that basis denies each and every such

1 allegation.

2 10. Answering paragraph 10, Defendant denies each and every allegation
3 contained therein.

4 11. Answering paragraph 11, Defendant admits the allegations contained
5 therein.

6 12. Answering paragraph 12, Defendant admits the allegations contained
7 therein.

8 13. Answering paragraph 13, Defendant denies each and every allegation
9 contained therein.

10 14. Answering paragraph 14, Defendant denies each and every allegation
11 contained therein.

12 15. Answering paragraph 15, Defendant lacks sufficient information to admit or
13 deny the allegations contained therein, and on that basis denies each and every such
14 allegation.

15 16. Answering paragraph 16, Defendant lacks sufficient information to admit or
16 deny the allegations contained therein, and on that basis denies each and every such
17 allegation.

18 17. Answering paragraph 17, Defendant denies each and every allegation
19 contained therein.

20 18. Answering paragraph 18, Defendant denies each and every allegation
21 contained therein.

22 19. Defendant admits that it has maintained its allegation of trademark
23 infringement. Except as expressly admitted herein, Defendant denies each and every
24 allegations contained in this paragraph.

25 20. Answering paragraph 20, Defendant admits the allegations contained
26 therein.

27 21. Answering paragraph 21, Defendant denies each and every allegation
28 contained therein.

1 22. Answering paragraph 22, Defendant denies each and every allegation
2 contained therein.

3 **FIRST CLAIM FOR RELIEF**
4 **(Declaratory Judgment of Non-Infringement of Trademark Rights)**

5 23. Answering paragraph 23, Defendant incorporates its responses to
6 paragraphs 1-22, inclusive.

7 24. Answering paragraph 24, Defendant denies each and every allegation
8 contained therein.

9 25. Answering paragraph 25, Defendant denies each and every allegation
10 contained therein.

11 26. Answering paragraph 26, Defendant denies each and every allegation
12 contained therein.

13 **PRAYER FOR RELIEF**

14 Defendant ABM Wireless, Inc. d/b/a Mobileistic denies that Plaintiff is entitled to
15 any damages or other relief sought by reason of the Complaint, or to any relief
16 whatsoever, against Defendant. As to the remaining allegations in the prayer, Defendant
17 denies each and every allegation contained therein.

18 **DEMAND FOR JURY TRIAL**

19 Defendant ABM Wireless, Inc. d/b/a Mobileistic hereby demands a trial by jury
20 on all triable issues.

21 **AFFIRMATIVE DEFENSES**

22 Defendant ABM Wireless, Inc. d/b/a Mobileistic pleads and asserts the following
23 separate and distinct affirmative defenses without assuming the burden of proof borne by
24 Plaintiff or conceding that it bears the burden of proof as to any of these issues.
25 Defendant reserves the right to assert additional affirmative defenses that discovery
26 indicates are proper.

FIRST AFFIRMATIVE DEFENSE

(Failure to State a Claim)

Plaintiff's Complaint, and each cause of action alleged therein, fails to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

(Ongoing Investigation)

Defendant has not yet completed a thorough investigation or study or completed the discovery of all the facts and circumstances of the subject matter of the Complaint and, accordingly, reserves the right to amend, modify, revise or supplement its answer and to plead such other defenses and take such other further actions as it may deem proper and necessary in its defense upon completion of said investigation and/or study.

WHEREFORE, Defendant ABM Wireless, Inc. d/b/a Mobileistic prays for relief as follows:

1. That the Complaint be dismissed, with prejudice and in its entirety;
2. That Plaintiff take nothing by reason of its Complaint and that judgment be entered against Plaintiff and in favor of Defendant;
3. That Defendant be awarded its costs of suit incurred in this action;
4. That Defendant be awarded any reasonable attorney's fees pursuant to the Trademark Act, 15 U.S.C. § 1117; or otherwise *and*
5. That Defendant be granted such other and further relief as the Court may deem just and proper.

1 DATED: November 13, 2014

Respectfully Submitted,

2 **SINGH, SINGH & TRAUBEN, LLP**
3 **MICHAEL A. TRAUBEN**

4
5 By: /s/ Michael A. Trauben
6 Michael A. Trauben

7 **MORITT, HOCK & HAMROFF, LLP**
8 **BRIAN A. BLOOM**

9
10 By: /s/ Brian A. Bloom
11 Brian A. Bloom

12 *Attorneys for Defendant/Counterclaimant*
13 ABM WIRELESS, INC.

EXHIBIT C

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Attorneys for Defendant/Counterclaimant

ABM WIRELESS, INC.

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

MOHPIE, INC., a California corporation,

Plaintiff,

v.

ABM WIRELESS, INC. d/b/a MOBILEISTIC, a)
New York corporation,

Defendant.

ABM WIRELESS, INC., a New York
corporation,

Counterclaimant,

v.

MOHPIE, INC., a California corporation,

Counterdefendant.

) Case No.: SACV 14-01422 JLS(RNBX)

)

) The Hon. Josephine L. Staton, Courtroom 10A

)

) **COUNTERCLAIM OF ABM WIRELESS, INC.**

) **FOR:**

1. **TRADEMARK INFRINGEMENT (15 U.S.C. §1114);**
2. **FALSE DESIGNATION OF ORIGIN AND UNFAIR COMPETITION;**
3. **VIOLATION OF CALIFORNIA BUSINESS AND PROFESSIONAL CODE §§ 17200 AND 17500); and**
4. **COMMON LAW TRADEMARK INFRINGEMENT AND UNFAIR COMPETITION**

) COMPLAINT FILED: September 5, 2014

) TRIAL DATE: None Set

)

)

1 Defendant/Counterclaimant ABM Wireless, Inc. d/b/a Mobileistic (“Mobileistic”
2 or “Counterclaimant”), by and through its undersigned counsel, hereby brings this
3 Counterclaim against Plaintiff/Counterdefendant Mohpie, Inc. (“Mohpie” or
4 “Counterdefendant”) for (i) Trademark Infringement; (ii) False Designation of Origin
5 and Unfair Competition; (iii) Violation California Business and Professional Codes §§
6 17200 and 17500; and (iv) Common Law Trademark Infringement and Unfair
7 Competition, and alleges the following based on its own records, and information and
8 belief:

9 **INTRODUCTION**

10 1. This is an action for trademark infringement in violation of Section 32 of
11 the United States Trademark Act of 1946, as amended, 15 U.S.C. §1114; for false
12 designation of origin and unfair competition in violation of Section 43(a) of the United
13 States Trademark Act of 1946, as amended, 15 U.S.C. §1125(a); for unfair competition
14 in violation of California Business and Professional Code §§17200 and 17500; and for
15 related claims of common law trademark infringement and unfair competition.

16 **JURISDICTION AND VENUE**

17 2. This Court has jurisdiction over the subject matter of these counterclaims
18 pursuant to 15 U.S.C. §1121, 28 U.S.C. §§1331, 1338(a) and (b), and 1367.

19 3. Venue is proper within this judicial district under 28 U.S.C. §1391(b) & (c).

20 **PARTIES**


21 4. ABM Wireless, Inc. is a New York Corporation doing business under the
22 name Mobileistic, having a principal place of business located at 205 Marcus Blvd.,
23 Hauppauge, New York 11788.

24 5. Upon information and belief, Counterdefendant Mophie is a corporation
25 organized and existing under the laws of the State of California, having its principal place
26 of business at 15101 Red Hill Avenue, Tustin, California 92780.

27 6. Upon information and belief, Mophie resides in this judicial district and is
28 subject to the jurisdiction of this Court.

STATEMENT OF FACTS


7. Counterclaimant Mobileistic is engaged in, among other things, the business of offering telecommunication products and cellular phone accessories, including cell phone cases, headphones, chargers, external speakers and cables.

8. Mobileistic is the owner of U.S. Trademark Registration No. 4,011,446 (the “446 Registration”), for the stylized mark  (“Mobileistic Circle M Mark”), for use in connection with the goods identified therein, including cellular phone accessories such as cell phone cases, headphones, chargers, external speakers and cables. A true and correct copy of the 446 Registration is attached hereto as Exhibit “A”.

9. The Mobileistic Circle M Mark is used extensively by Mobileistic in connection with its business and appears prominently on its products and packaging, as well as in advertising and promotional materials.

10. Mobileistic has continuously used its Mobileistic Circle M Mark in commerce, in connection with cell phones, cell phone accessories, and/or other goods, since at least as early as January 1, 2006.

11. The 446 Registration is evidence of Mobileistic’s exclusive right to use the Mobileistic Circle M Mark in connection with at least the goods identified therein.

12. Upon information and belief, Mophie uses the mark  (the “Mophie Mark”) in connection with the sale and offering for sale of a variety of goods, including protective cases for cell phones.

13. Upon information and belief, Mophie did not begin use of the Mophie Mark in connection with protective cases for cell phones until after Mobileistic began use of the Mobileistic Circle M Mark.

FIRST CLAIM FOR RELIEF
(TRADEMARK INFRINGEMENT 15 U.S.C. §1114)

14. Mobileistic hereby repeats and re-alleges paragraphs 1-13 above as if fully set forth herein.

15. Mophie’s use of the Mophie Mark is without the authorization of

1 Mobileistic.

2 16. Mophie's use of the Mophie Mark in connection with at least protective
3 cases for cellular phones, so nearly resembles, and is virtually identical to Mobileistic's
4 Federally registered Mobileistic Circle M Mark, so as to be likely to cause confusion and
5 mistake, and to deceive, and to make consumers mistakenly believe that such goods are
6 Mobileistic's goods, or that such goods are sponsored or approved by, or somehow
7 connected with or related to Mobileistic.

8 17. The aforesaid acts of Mophie constitute infringement of Mobileistic's
9 Federally registered Mobileistic Circle M Mark, in violation of 15 U.S.C. §1114.

10 18. Upon information and belief, the aforesaid acts of Mophie were undertaken
11 willfully and deliberately with knowledge of Mobileistic's prior trademark rights in the
12 Mobileistic Circle M Mark.

13 19. Mobileistic has been and, absent injunctive relief, will continue to be
14 irreparably harmed by Mophie's aforesaid actions, and has further suffered monetary
15 damages in an amount to be determined at trial.

16 20. Mobileistic has no adequate remedy at law.

17 **SECOND CLAIM FOR RELIEF**
18 **(FALSE DESIGNATION OF ORIGIN AND UNFAIR COMPETITION)**

19 21. Mobileistic hereby repeats and re-alleges paragraphs 1-20 above as if fully
20 set forth herein.

21 22. Mophie's use in commerce of the Mophie Mark, in connection with at least
22 protective cases for cell phones, so nearly resembles, and is virtually identical to
23 Mobileistic's Mobileistic Circle M Mark, so as to be likely to cause confusion and
24 mistake, and to deceive, and to make consumers mistakenly believe that such goods are
25 Mobileistic's goods, or that such goods are sponsored by, approved by or somehow
26 connected with Mobileistic, with consequent injury to consumers and Mobileistic.

27 23. The aforesaid acts of Mophie constitute unfair competition and false
28 designation of origin in violation of 15 U.S.C. §1125(a).

1 24. Upon information and belief, the aforesaid acts of Mophie were undertaken
2 with knowledge of Mobileistic's prior trademark rights in the Mobileistic Circle M
3 Mark.

4 25. Mobileistic has been and, absent injunctive relief, will continue to be
5 irreparably harmed by Mophie's aforesaid actions, and has further suffered monetary
6 damages in an amount to be determined at trial.

7 26. Mobileistic has no adequate remedy at law.

8 **THIRD CLAIM FOR RELIEF**
9 **VIOLATION OF CALIFORNIA BUSINESS AND**
10 **PROFESSIONAL CODE §§17200 AND 17500**

11 27. Mobileistic hereby repeats and re-alleges paragraphs 1-26 above as if fully
12 set forth herein.

13 28. By reason of its deliberate and willful acts as set forth above, Mophie has
14 engaged in unfair competition in the conduct of its business in violation of California
15 Business and Professional Code §§17200 and 17500.

16 29. Mobileistic has been and, absent injunctive relief, will continue to be
17 irreparably harmed by Mophie's aforesaid actions, and has further suffered monetary
18 damages in an amount to be determined at trial.

19 30. Mobileistic has no adequate remedy at law.

20 **FOURTH CLAIM FOR RELIEF**
21 **COMMON LAW TRADEMARK INFRINGEMENT**
22 **AND UNFAIR COMPETITION**

23 31. Mobileistic hereby repeats and re-alleges paragraphs 1-30 above as if fully
24 set forth herein.

25 32. The aforesaid acts of Mophie constitute trademark infringement and/or
26 unfair competition and/or unfair trade practices under the common law of the State of
27 California.

28 33. Upon information and belief, Mophie's aforesaid acts were undertaken by
Mophie with the willful intent of trading upon Mobileistic's reputation and good will.

1 34. Mobileistic has been and, absent injunctive relief, will continue to be
2 irreparably harmed by Mophie's aforesaid actions, and has further suffered monetary
3 damages in an amount to be determined at trial.

4 35. Mobileistic has no adequate remedy at law.

5 **PRAYER FOR RELIEF**

6 **WHEREFORE,** Defendant/Counterclaimant ABM Wireless, Inc. d/b/a
7 Mobileistic respectfully requests that this Court enter a final judgment in its favor and as
8 against Plaintiff/Counterdefendant Mohpie, Inc., and prays for relief as follows:

9 1. That Mophie take nothing by its Complaint and that judgment on the
10 Complaint be entered if favor of Mobileistic;

11 2. That Mophie's use of the Mophie Mark constitute:

- 12 a. trademark infringement in violation of 15 U.S.C. §1114;
13 b. false designation of origin and unfair competition in violation of 15
14 U.S.C. §1125(a);
15 c. unfair competition and false advertising in violation of California
16 Business & Professional Code §§17200 and 17500; *and*
17 d. trademark infringement and unfair competition in violation of the
18 common law of the State of California.

19 3. That Mophie and its officers, directors, agents, servants, employees,
20 attorneys and those persons in active concert or participation or otherwise in privity with
21 it, or any of them, be preliminarily and permanently enjoined from using in any manner
22 the aforesaid Mophie Mark and variations thereof, or any other name, term, phrase,
23 mark, design, device or symbol which so resembles or is similar to the Mobileistic Circle
24 M Mark, so as to be likely to cause confusion, mistake, or deception as to source, origin,
25 sponsorship, approval, affiliation or the like;

26 4. That Mophie deliver up for destruction all products, labels, signs, prints,
27 packages, wrappers, receptacles, advertisements or other materials in its possession,
28 custody or control, and in the possession, custody or control of those in active concert or

1 participation or otherwise in privity with it, which display or contain the Mophie Mark,
2 or variations thereof, or which constitute and/or bear any other device, representation, or
3 statement in violation of the injunction herein requested by Mobileistic, and that Mophie
4 be ordered to deliver up for destruction all plates, molds, matrices and other means for
5 making the same;

6 5. That Mophie file with the Court and serve upon Mobileistic, within thirty
7 (30) days after service upon Mophie of this Court's injunction issued in this action, a
8 written report, signed under oath, setting forth in detail the manner and form in which
9 Mophie has complied with such injunction;

10 6. That Mophie be required to account to Mobileistic for its profits, income
11 receipts, gains and advantages derived by Mophie from its acts of infringement and other
12 unlawful conduct, and for such sum in addition thereto as the Court shall find just;

13 7. Awarding Mobileistic its damages arising out of Mophie's infringement and
14 other unlawful acts, together with an amount which is three times the amount found as
15 actual damages, pursuant to 15 U.S.C. §1117;

16 8. Awarding Mobileistic punitive damages based on Mophie's willful, wanton
17 and intentional conduct;

18 9. Awarding Mobileistic its costs and disbursements, including reasonable
19 attorneys' fees; and

20 10. Awarding Mobileistic such other and further relief as to the Court seems
21 just and proper.

22 **DEMAND FOR JURY TRIAL**

23 Defendant/Counterclaimant ABM Wireless, Inc. d/b/a Mobileistic hereby
24 demands a trial by jury on all triable issues.

1 DATED: November 13, 2014

Respectfully Submitted,

2 **SINGH, SINGH & TRAUBEN, LLP**
3 **MICHAEL A. TRAUBEN**

4
5 By: /s/ Michael A. Trauben
6 Michael A. Trauben

7 **MORITT, HOCK & HAMROFF, LLP**
8 **BRIAN A. BLOOM**

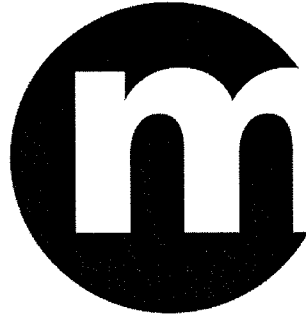
9
10 By: /s/ Brian A. Bloom
11 Brian A. Bloom

12 *Attorneys for Defendant/Counterclaimant*
13 ABM WIRELESS, INC.

EXHIBIT “A”

United States of America

United States Patent and Trademark Office



Reg. No. 4,011,446

Registered Aug. 16, 2011

Int. Cls.: 9 and 35

TRADEMARK

SERVICE MARK

PRINCIPAL REGISTER

ABM WIRELESS, INC. (NEW YORK CORPORATION), DBA MOBILEISTIC
205 MARCUS BLVD.
HAUPPAUGE, NY 11788

FOR: TELECOMMUNICATION PRODUCTS AND CELLULAR PHONE ACCESSORIES, NAMELY, WIRELESS EQUIPMENT IN THE NATURE OF CELLULAR PHONES, HEADSETS FOR CELL PHONES, EARPHONES, CELLULAR PHONE BATTERY CHARGERS, BATTERIES, MEMORY CARDS, ANTENNAS, ELECTRONIC DATA CABLES, CARRYING CASES FOR CELL PHONES, ADAPTERS AND ACCESSORIES FOR PORTABLE MUSIC PLAYERS IN THE NATURE OF CARRYING CASES AND PROTECTIVE COVERS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 1-1-2006; IN COMMERCE 1-1-2006.

FOR: DISTRIBUTORSHIP SERVICES AND RETAIL STORE SERVICES IN THE FIELD OF TELEPHONE HANDSETS AND TELECOMMUNICATION PRODUCTS, CELLULAR PHONES AND CELLULAR PHONE ACCESSORIES, NAMELY, WIRELESS EQUIPMENT, CHARGERS, BATTERIES, MEMORY CARDS, HEADSETS, DATA CABLES, ANTENNAS, CASES, NAVIGATION EQUIPMENT, ADAPTORS, ACCESSORIES FOR PORTABLE MUSIC PLAYERS; RETAIL STORE SERVICES FEATURING TELECOMMUNICATIONS SERVICE PLANS AND TELECOMMUNICATIONS SERVICE ACTIVATION, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 1-1-2006; IN COMMERCE 1-1-2006.

OWNER OF U.S. REG. NO. 3,804,632.

THE MARK CONSISTS OF THE LOWER CASE LETTER "M" SUBSTANTIALLY CONTAINED WITHIN A DARKER CIRCLE AND PARTIALLY FORMING THE RIGHT BORDER OF THE CIRCLE.

SER. NO. 85-164,047. FILED 10-28-2010.

WILLIAM VERHOSEK, EXAMINING ATTORNEY



David J. Kypos

Director of the United States Patent and Trademark Office